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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/369,960	08/06/99	CAMPBELL	R KANG113878

CHRISTENSEN O CONNOR
JOHNSON & KINDNESS
1420 FIFTH AVENUE
SUITE 2800
SEATTLE WA 98101-2147

LM02/0608

EXAMINER

CORRIELUS, J

ART UNIT	PAPER NUMBER
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2771

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4

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/369,960

Applicant(s)
David Campbell

Examiner
Jean M. Corrielus

Group Art Unit
2771



☒ Responsive to communication(s) filed on Aug 6, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-16 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☒ Claim(s) 16 is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2771:

DETAILED ACTION

1. This first office action is in response to the application filed on August 16, 1999, which claims 1-16 are presented for examination.

2. The filing receipt correction filed on 11/18/99 (paper 3) has been revised. The information referred to therein has been considered as to the merits.

Information Disclosure Statement

3. The information disclosure statement filed on 11/18/99 (paper no.2) complies with the provisions of M.E.P.. § 609. It has been placed in the application file. The information referred to therein has been considered as to the merits.

Specification

4. Applicant is suggested to amend the specification in page 1, before the background of the invention is amended to recite --This a continuation of application Serial. No. 08/452,596, filed May 25, 1995, which is U.S. Patent No. 5,694, 596 and continuation of application Serial. No. 08/969,134, filed November 12, 1997, which is U.S. Patent No.5,937,405--.

Drawings

5. The drawings filed on August 06, 1999 are acceptable. (See PTO 948).

Art Unit: 2771:

Claim Rejections - 35 U.S.C. § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "***via the network***" in step (b), line 1. There is insufficient antecedent basis for this limitation in the claim. For examination purposes, the examiner has considered the limitation "***via the network***" to be ***--via the common communications link--***. In light of the above, the applicant is suggested to amend the claim to resolve the antecedent basis problem in the claim.

Claim 14 recites "***via the network***" in line 4. There is insufficient antecedent basis for this limitation in the claim. It is suggested that the Applicants amend the claim to resolve the antecedent basis problem in the claim.

Claim Objections

8. Claims 12-14 and 16 are objected to because of the following informalities: Claim 12, step(b) recites "downloading via the network the at least one module block of **updated information from the first peer computer to the second peer computer**". However, the preamble of the claim set forth download from the second peer computer the updated information to first peer computer in order to update the outdated information stored in the first computer. For examination purpose, the examiner

Art Unit: 2771:

has considered the limitations "downloading via the network the at least one module block of updated information from the first peer computer to the second peer computer" to be "downloading via the network the at least one module block of updated information from the second peer computer to the first peer computer". In light of the above, the applicant is suggested to amend the claim to resolve the objection problem in the claim.

9. Claims 13-14 are objected for fully incorporating the errors of the respective base claims by dependency.

10. In claim 16, it is suggested that the ",", after information, in step (c) be replaced by --;--.

Double Patenting

11. The nonstatutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. See *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985) and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) and may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground

Art Unit: 2771:

provided the conflicting application or patent is shown to be commonly owned with this application.

See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 4-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-6, 9, 11-12 of U.S. Patent No.5,937,405. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Claim 1 of the cited patent and claim 4 of the present application recites the following:

Patent claim 1

1. A method for updating modules of information via a network comprising a plurality of terminals, the method comprising:
(a) identifying a first module containing information to be updated, wherein the first module is stored in memory of a first terminal, and wherein the first module comprises a plurality of first module blocks;
(b) identifying a second module containing more recent information than the first module, wherein the second module is stored in memory of a second terminal, and wherein the second module comprises a plurality of second module blocks;
(c) identifying which second module blocks contain more recent information than the first module blocks;
(d) downloading via the network the identified second module blocks from memory of the second terminal to the first terminal; and
(e) updating the first module stored in memory of the first terminal with the more recent information contained in the identified second module blocks downloaded from memory of the second terminal.

Application claim 4

4. A method for updating modules of information via a network comprising a plurality of computers, the method comprising:
(a) identifying a first module containing information to be updated, wherein the first module is stored in memory of a first computer, and wherein the first module comprises a plurality of first module blocks;
(b) identifying a second module containing more recent information than the first module, wherein the second module is stored in memory of a second computer, and wherein the second module comprises a plurality of second module blocks;
(c) identifying which second module blocks contain more recent information than the first module blocks;
(d) downloading via the common communications channel the identified second module blocks from memory of the second computer to the first computer; and
(e) updating the first module stored in memory of the first computer with the more recent information contained in the identified second module blocks downloaded from memory of the second computer.

Art Unit: 2771:

It would have been obvious to one of ordinary skill in the art of data processing at the time the invention was made to modify claim 1 of the cited patent by replacing a terminal with a computer and a network with a common communications channel. The cited substitute elements would not interfere with the functionality of the steps previously claimed and would perform the same function of updating modules of information. In re Karlson, 136 USPQ 184 (CCPA 1963).

Claims 2, 4 and 5 of the cited patent and claims 5, 6 and 7 of the present application recite the following:

Patent Claim 2

2. The method of claim 1, further comprising repeating (b) through (e) of claim I for each of a plurality of modules identified as containing information to be updated.

Application claim 5

5. The method of claim 4, further comprising repeating (b) through (e) of claim I for each of a plurality of modules identified as containing information to be updated.

Patent Claim 4

4. The method of claim 1, wherein identifying the second module containing more recent information than the first module comprises comparing the first module to the second module to determine if the second module contains more recent information than the first module.

Application claim 6

6. The method of claim 4, wherein identifying the second module containing more recent information than the first module comprises comparing the first module to the second module to determine if the second module contains more recent information than the first module.

Patent claim 5

Application claim 7

Art Unit: 2771:

5. The method of claim 4, wherein identifying which second module blocks contain more recent information than the first module blocks comprises comparing each second module block, to each first module block to determine if the second module block has more recent information than the first module block.

7. The method of claim 6, wherein identifying which second module blocks contain more recent information than the first module blocks comprises comparing each second module block, to each first module block to determine if the second module block has more recent information than the first module block.

Claims 5, 6 and 7 of the Patent application are essentially the same as claims 2, 4 and 5 of the US patent cited above.

Claim 6 of the cited patent and claim 8 of the present application recites the following:

Patent Claim 6

6. The method of claim 1, wherein updating the first module stored in memory of the first terminal comprises updating each of the first module blocks with the more recent information contained in each of the identified second module blocks downloaded from memory of the second terminal.

Application claim 8

8. The method of claim 4, wherein updating the first module stored in memory of the first computer comprises updating each of the first module blocks with the more recent information contained in each of the identified second module blocks downloaded from memory of the second computer.

It would have been obvious to one of ordinary skill in the art of data processing at the time the invention was made to modify claim 6 of the cited patent by replacing a terminal with a computer. The cited substitute elements would not interfere with the functionality of the steps previously claimed and would perform the same function of updating modules of information. In re Karlson, 136 USPQ 184 (CCPA 1963).

Claim 9 of the cited patent and claim 9 of the present application recite the following:

Art Unit: 2771:

Patent claim 9

9. The method of claim 1, further comprising:
(a) identifying an nth module containing more recent information than The first module, wherein the nth module is stored in memory of an nth terminal, and wherein the nth module comprises a plurality of nth module blocks;
(b) identifying which nth module blocks contain more recent information than the first module blocks;
(c) downloading via the network the identified nth module blocks from memory of the nth terminal to the first terminal; and
(d) updating the first module stored in memory of the first terminal with the more recent information contained in the identified nth module blocks downloaded from memory of the nth terminal.

Application claim 9

9. The method of claim 4, further comprising:
(a) identifying an nth module containing more recent information than The first module, wherein the nth module is stored in memory of an nth computer, and wherein the nth module comprises a plurality of nth module blocks;
(b) identifying which nth module blocks contain more recent information than the first module blocks;
(c) downloading via the network the identified nth module blocks from memory of the nth computer to the first computer; and
(d) updating the first module stored in memory of the first computer with the more recent information contained in the identified nth module blocks downloaded from memory of the nth computer.

It would have been obvious to one of ordinary skill in the art of data processing at the time the invention was made to modify claim 9 of the cited patent by replacing an nth terminal with a an nth computer. The cited substitute elements would not interfere with the functionality of the steps previously claimed and would perform the same function of updating modules of information. In re Karlson, 136 USPQ 184 (CCPA 1963).

Claim 11 of the cited patent and claim 10 of the present application recite the following:

Patent claim 11

11. The method of claim 10, wherein at least one of the first module, the second module and the nth module comprises a module of information nested within another module of information.

Application Claim 10

10. The method of claim 9, wherein at least one of the first module, the second module and the nth module comprises a module of information nested within another module of information.

Claim 10 of the US application is essentially the same as claim 11 of the US patent.

Art Unit: 2771:

Claim 12 of the cited patent and claim 11 of the present application recite the following:

Patent claim 12

12. The method of claim 1, further comprising:
(a) identifying an nth module containing new information, wherein the nth module is stored in memory of an nth terminal, and wherein the nth module comprises a plurality of nth module blocks;
(b) identifying which nth module blocks contain new information;
(c) downloading via the network the identified nth module blocks from memory of the nth terminal to the first terminal; and
(d) updating the first module stored in memory of the first terminal with the new information contained in the identified nth module blocks downloaded from memory of the nth terminal.

Application claim 11

11. The method of claim 4, further comprising:
(a) identifying an nth module containing new information, wherein the nth module is stored in memory of an nth computer, and wherein the nth module comprises a plurality of nth module blocks;
(b) identifying which nth module blocks contain new information;
(c) downloading via the network the identified nth module blocks from memory of the nth computer to the first computer; and
(d) updating the first module stored in memory of the first computer with the new information contained in the identified nth module blocks downloaded from memory of the nth computer.

It would have been obvious to one of ordinary skill in the art of data processing at the time the invention was made to modify claim 12 of the cited patent by replacing an nth terminal with a an nth computer. The cited substitute elements would not interfere with the functionality of the steps previously claimed and would perform the same function of updating modules of information. In re Karlson, 136 USPQ 184 (CCPA 1963).

Claim Rejections - 35 U.S.C. § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2771:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

14. Claims 1-3, 12-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakagawa et al US Patent No. 5,835,911.

As to claim 12:

Nakagawa discloses substantially the invention as claimed, including a method and a system for providing a software distribution or maintenance over a network. The method implemented with Nakagawa's system is simply expressed as a method of communications between processes over a general-purpose network, which may be either in peer to peer network or in group to group network performed in a ration of 1 to 1 and a ratio of group to group (col.88, lines 33-38). In particularly, Nakagawa teaches the claimed "comparing a module outdated information stored in memory of a first peer computer to a module of more recent information stored in memory of the second peer computer, wherein the module of outdated information includes a plurality of module blocks at least one of which contains outdated information, and wherein the module of updated information includes a plurality of module bocks at least one of which contain updated information and corresponds to the at least one module block of outdated information" as a means for the server program in the vendor computer 22 (second peer computer) to compare information inquiry from the client program in the user computers 21-1 and 21-2 (first peer computer) with the corresponding software library (col.29; lines 19-21, 25-36). Nakagawa

Art Unit: 2771:

further teaches the claimed “ downloading via the network the at least one module block of updated information from the second peer computer to the first peer computer” as a means for automatically transmitting via the network 23 the updated instruction from the server program in the vendor computer 22 (second peer computer) to the client program in the user computers 21-1 and 21-2 (first peer computer) (col.29, line 67). Last, Nakagawa teaches the claimed “replacing the at least one module block containing outdated information with the at least one module block containing updated information which was downloaded via the common communications link” as a means for updating user software s1 and s2 together with updated software modules (col.29, lines 23-24).

As to claim 13:

Nakagawa teaches the claimed “wherein comparing the module of outdated information stored in memory of the first peer computer to the module of the more recent information stored in memory of the second peer computer comprises comparing each module block of outdated information to a corresponding module block of updated information to identify the at least one module block containing updated information” as a means for the server program in the vendor computer 22 (second peer computer) to compare information inquiry from the client program in the user computers 21-1 and 21-2 (first peer computer) with the corresponding software library (col.29, lines 19-21, 25-36).

Art Unit: 2771:

As to claim 14:

Nakagawa teaches the claimed “ wherein comparing each module block of outdated information to a corresponding module block of updated information identifies a plurality of module blocks in the updated module containing updated information, wherein the plurality of module blocks containing updated information are downloaded via the network from the second peer computer to the first peer computer, and wherein the module blocks containing outdated information are replaced with the plurality of module blocks containing updated information” as a means for the server program in the vendor computer 22 (second peer computer) to compare information inquiry from the client program in the user computers 21-1 and 21-2 (first peer computer) with the corresponding software library (col.29, lines 19-21, 25-36) and automatically transmitting via the network 23 the updated instruction from the server program in the vendor computer 22 (second peer computer) to the client program in the user computers 21-1 and 21-2 (first peer computer) (col.29, line 67).

As to claims 1-3:

Claim 1-3 are for computer readable medium containing computer executable component performed by the method of claims 12-14 and are similarly rejected.

As to claim 15:

Art Unit: 2771:

Nakagawa substantially discloses the invention as claimed, including a method and a system for providing a software distribution and maintenance over a network. The method implemented with Nakagawa's system is simply expressed as a method of communications between processes over a general-purpose network, which may be either in peer to peer network or in group to group (client server network) performed in a ration of 1 to 1 and a ratio of group to group (col.88, lines 33-38). By receiving a request from the server program in the vendor computer for updating the software modules to the client program in the user computer through the use of the network 23 (col.8, lines 31-38), Nakagawa inherently teaches the use of connecting a publishing computer to a subscribing computer. In particularly, Nakagawa teaches the claimed "subscribing to publish information stored in memory of the publishing computer " as a means for transmitting an inquiry over the network to the server program in the vendor computer (publisher) requesting information on the current version of the software (col.29, lines 50-67). Second, Nakagawa teaches the claimed " comparing the information stored in memory of the subscribing computer to the published information stored in memory of the publishing computer" as a means for the server program in the vendor computer 22 (publisher computer) to compare information inquiry from the client program in the user computers 21-1 and 21-2 (subscriber computer) with the corresponding software library (col.29, lines 19-21, 25-36). Third, Nakagawa teaches the claimed " responsive to the published information stored in memory of the publishing computer having been from the information stored in memory of the subscribing computer, identifying which published information stored in the memory of the publishing computer has been changed" as a

Art Unit: 2771:

means for verifying which module information have been updated (col.30, lines 3-5). Fourth, Nakagawa teaches the claimed “downloading from the publishing computer to the subscribing computer via the network only that published information which has changed from the information stored in the memory of the subscribing computer” as a means for automatically transmitting via the network 23 the updated instruction from the server program in the vendor computer 22 (publishing computer) to the client program in the user computers 21-1 and 21-2 (subscribing computer) (col.29, line 67). Last, Nakagawa teaches the claimed “updating the information stored in memory of the subscribing computer only with that published information which has changed and has been downloaded from the publishing computer” as a means for updating user (subscribing computer) software s1 and s2 together with updated software modules returned by the server program in the vendor computer (Publishing computer)(col.29, lines 23-24).

15. Claim 16 would be allowable if rewritten to overcome the objection(s) set forth in this office action.

Allowable Subject Matter

16. The present application has been thoroughly reviewed. Upon extensive and exhaustive searches of various databases (see search notes in case jacket), the examiner respectfully submits that claim 16 is allowable over the prior art made of record (PTO-892, PTO-1449).

Art Unit: 2771:

Reason For Indicating Allowable Subject Matter

17. The present invention is directed to a method and a system for updating modules of information via an on-line communication network. The closest prior art, Nakagawa et al (US Patent No 5,835,911) discloses a software distribution and maintenance system and method over a network so that a number of various software vendors and users can systematically manage plural sets of various object software. However, Nakagawa et al, either singularly or in combination, fails to anticipate or render obvious the recited limitations "identifying a first host module stored in host memory that corresponds to the first user module, wherein each first host module block corresponds to a first user module block, wherein at least one first host module block comprises a second host module of information, and wherein the second host module corresponds to the second user module; and if the first host module block comprises a second host module of information, comparing each second host module block to the corresponding second user module block to determine if the second host module block contains more recent information than the corresponding second user module block" in the claim 16.

Art Unit: 2771:

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached PTO-892.

1. US. Patent no. 4,558,413, issued to Schmidt et al. on 12/10/85. The subject matter disclosed therein is pertinent to that of claims 1-3, 12-15 (e.g. updating outdated software version from the user computer to the more recent software version).

2. US. Patent no. 5,388,258, issued to Larsson et al. on 02/07/95. The subject matter disclosed therein is pertinent to that of claims 1-3, 12-15 (e.g. updating outdated software version from the user computer to the more recent software version).

3. US. Patent no. 5,572,727, issued to Larsson et al. on 11/05/1996. The subject matter disclosed therein is pertinent to that of claims 1-3, 12-15 (e.g. updating outdated software version from the user computer to the more recent software version).

Serial Number: 09/369,960:

Page 17

Art Unit: 2771:

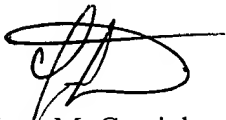
Any inquiry concerning this communication or early communication from the Examiner should be directed to **Jean M. Corrielus** whose telephone number is (703) 306-3035. The Examiner can normally be reached on Tuesday-Friday from 7:00am to 5:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu, can be reached on Monday-Friday from 9:00 a.m.-6:00 p.m. at (703)305-4393.

Any response to this action should be mailed to: Commissioner of Patents and Trademarks Washington, D.C. 20231 **or faxed to:** (703) 308-9051, (for formal communications intended for entry)

Or: (703)305-9731 (for informal or draft communications, please label "PROPOSED" or "DRAFT") Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-9600.



Jean M. Corrielus

Patent Examiner

May 27, 2000